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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,549	06/19/2001	Michael J. Lemon	10007916-1	2371

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

LIU, MING HUN

ART UNIT	PAPER NUMBER
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2675

DATE MAILED: 02/25/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

DM

Office Action Summary

Application No.

09/884,549

Applicant(s)

LEMON, MICHAEL J.

Examiner

Ming-Hun Liu

Art Unit

2675

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Information Disclosure Statement

1. The prior art material is missing. If possible please supply the office with a secondary copy.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,456,307 to Bates.

In reference to claim 1, Bates teaches an annotating system for Internet data addresses where the device allocates a temporary location that links the location to the address of a preselected Internet website (column 2, lines 20-23). Several marked locations can be generated and each are symbolically linked to their respective Internet websites (column 3, lines 23-26). The Internet website is invoked when the user selects the icon (column 10, lines 46-47).

However, Bates does not go into depth on the possible GUI alternatives in this annotation system.

On column 5, lines 26-29, Bates acknowledges that several different inputting methods are possible specifically sighting a graphic tablet as the first alternative to the conventional mouse. As one skilled in the art understands, graphical tablets inherently include styluses for pointing and invocation purposes. Therefore from aforementioned concession of Bates, it is

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understood that selecting process as understood in Bates' disclosure includes selecting with pointing devices alternative devices such as the graphical tablet and stylus combination.

In reference to 2, figure 11B of Bates demonstrates a first surface region where the annotating function commands are implemented (area 750).

4. Claims 3, 5-15 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over combination Bates and US patent 5,592,607 to Weber et al.

In reference to claim 3, Bates describes an Internet address representation scheme that is similar to the applicant's claimed invention. The functionality of the Bates and the applicant's inventions is essentially synonymous, however their method of annotation differs. Bates' invention uses the computer to generate customizable graphical bookmarks of the webpage whereas the applicant's invention allows the user to create freehand graphical bookmarks of the webpage.

Weber teaches an invention that allows the user to link freehand written images to certain addresses within the computer (column 1, line 25-30 and column 5, lines 4-16). Naturally Weber's invention differs from the applicant's invention where the applicant's device specifically links graphics to Internet addresses. As Weber teaches in column 4, lines 36-38, that an "address" of an event "is a point in a measurement dimension that can be used later to facilitate access to that point."

One skilled in the art understands that Internet addresses are certainly events that need to be recalled a fact that is well established by Bates.

It would have been obvious to combine Bates' and Weber's invention to serve as a new, intuitive event reference method for Internet addresses.

Claims 5 and 6 are rejected using the combination of Bates and Weber with the reasoning outlined in the rejection of claim 3. As Weber illustrates in figure 14, the graphical references are randomly located to represent separate links to separate addresses (column 25, lines 47-53).

In reference to claim 7, on column 26, line 34, Weber teaches that the maker can be deleted from the workspace.

Claim 8 is rejected on basis outlined in the rejection of claims 3, 5 and 6.

In reference to claim 9, Weber teaches that the location of the marker can also define the link to the address (column 6, lines 23-27).

In reference to claim 10, Weber does not explicitly state that erasing the marking will disassociate the location link to the Internet address, however such a disassociation is implied in the functionality of a deletion process. Weber teaches on column 26, lines 37-44 that the physical marking along with its address relationship is stripped from memory.

Claim 11 is rejected on the ground outlined in the rejection of claims 3 and 7.

In reference to claim 12, as seen from figures 14 and 15 that Weber teaches the uses of several function keys and stroke patterns for the functioning of the tablet.

Claim 13 is rejected on the ground outlined in the rejection of claim 9.

In reference to claim 14, Weber's invention allows the user to instantly retrieve an addressed event by selecting the corresponding graphical representation (column 26, 45-50).

Claim 15, 17 and 18 are rejected on basis outlined in the rejection of claim 8.

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Claim 19 is rejected on basis outlined in the rejection of claim 9.

In reference to claim 20, the concept of jumping from on address to address is anticipated by Weber and explained in the rejection of claim 14. Furthermore, this limitation is inherent to the definition of an Internet bookmark as Bates would attest. Bookmarks were created to allow the users to jump from site to site (column10, line 46-47).

Response to Arguments

5. Applicant's arguments with respect to claim 1-3,5-15 and 17-20 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ming-Hun Liu whose telephone number is 703-305-8488. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Saras can be reached on 703-305-9720. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

Ming-Hun Liu


DENNIS-DOON CHOW
PRIMARY EXAMINER